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10/813,861	03/31/2004	Edward Vaquero	P03505	5583

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/813,861
Filing Date: March 31, 2004
Appellant(s): VAQUERO, EDWARD

Jeffrey B. Powers
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 15, 2010 appealing from the Office action mailed July 21, 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 13-15, 18-23 and 25-31 are pending.

Claim 24 has been withdrawn.

Claims 1-12, 16, and 17 have been canceled.

Claims 13-15, 18-23, and 25-31 are rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office

action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

US 6,491,697	Clark et al.	12-2002
US 6,447,520	Ott et al.	9-2002
US 6,010,510	Brown et al.	1-2000

(9) Grounds of Rejection

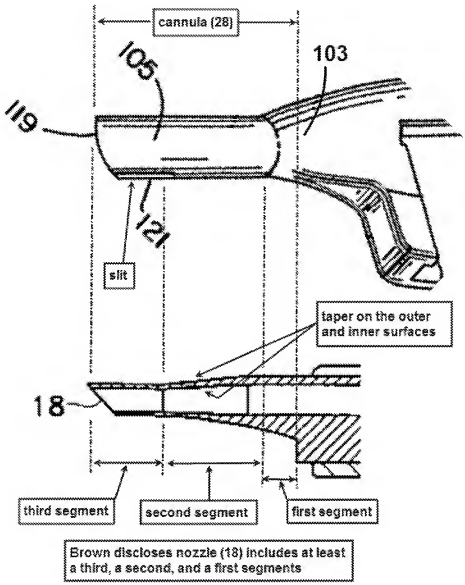
The following ground(s) of rejection are applicable to the appealed claims:

Claims 13-15, 18-23, 25, 26, and 28-31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al (U.S. 6,491,697) in view of Brown et al (U.S. 6,010,510).

Regarding claim 13, Clark discloses (see Fig. 1) an injector for delivering a foldable IOL into an eye, comprising: a tubular member (22) or an injector body having a cannula (28) or a tip comprising a proximal funnel-shaped portion (103) or first segment, an elongate distal portion (105) or a third segment, the elongate distal portion (105) or the third segment extending to an open end (see Fig. 1, reference number 119) of the injector body, the open end being adapted to permit the IOL (12) to exit the injector into

the eye, at least one slit (121) or slot (see Figs. 2-3) extending from the open end through a portion of the elongate distal portion (105) (col. 3, lines 50-65; col. 4, lines 55-68; col. 5, lines 58-68; and col. 6, lines 30-50).

Clark discloses the invention substantially as claimed except for disclosing the elongate distal portion (105) of the cannula (28) further comprises a second segment, wherein the second segment connected to the third segment at the transition point, the transition point characterized by a discrete change in taper. However, Brown discloses (see Fig. 4, reproduced and annotated below this paragraph) an IOL injector comprising, among other things, a nozzle (18) or tip comprising at least a third segment (see annotated figure below) having a constant diameter, a second segment (see annotated figure below) having a taper located on the outer surface and a taper located on the inner surface of bore 16. Apparently, the advantage of having a taper on the outer and inner surfaces on the second segment is for gradually compressing the IOL to fit through a small distal tip, which is the third segment (see annotated figure below), thereby, facilitate insertion of the nozzle into a small incision in the ocular tissue.



It would have been obvious to one of ordinary skill in the art to modify the shape of the elongate distal portion (105) of Clark to have a similar shape according to the nozzle (18) as suggested by Brown so that it too would have the same advantage. With respect to the limitation of "a slot extending from the open end through the second segment and the third segment", noting that the slit (121) as shown in Figure 3 of Clark reference is disposed at the distal tip and apparently, the slit extended substantially half

way of the length of the elongate distal portion (105) (see annotated figure above). According to the annotated figure above, the shape of the elongate distal portion (105) of Clark reference as modified by Brown would includes a first segment, a second segment, a third segment and a slot extending from the open end through the second segment and the third segment, the third segment connected to the second segment at a transition point, the transition point characterized by a change in taper.

Regarding claims 15, 18-23, 25, 29, 30 and 31, Clark discloses (see Figs. 1-6C) the elongate distal portion (105) having a constant diameter and two slits (121) disposed at the distal region of the tip. A slanted face (119) located at the distal end of the elongate distal portion (105) and a lumen (107), which extends through cannula (28). The lumen (107) is axially aligned with passage (76) of compressing station (26) or loading bay. A compressor drawer (40) extending from the loading bay (26) for receiving the IOL, wherein the drawer comprises a groove (70) (Fig. 6A-6C), which is aligned with the lumen grooves (68) and 76 (col. 3, lines 50-65; col. 4, lines 55-68; col. 5, lines 58-68; and col. 6, lines 30-50).

Regarding claim 14, Clark/Brown discloses the invention substantially as claimed except for disclosing the third segment having a constant diameter of about 2.0 to 2.5 mm. However, it is old and well known to make the size of the insertion segment of an IOL injector as small as possible in order to obtain the advantage of facilitate insertion of the injector into the eye through a small incision in ocular tissue, thereby, minimizing the invasiveness of the procedure. It would have been obvious to so size the distal tip of

Clark/Brown to have a diameter of about 2.0 to 2.5 mm so that it too would have this advantage.

Regarding claims 26 and 27 (were 25 and 26), Clark/Brown discloses the first segment (103) (see annotated figure) is unslotted and the first segment has a different taper than the second segment (see Fig. 1 and annotated figure).

Claim 28 (was 27) stand rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al. in view of Brown et al. as applied to claim 13 above and further in view of Ott et al. (US 6,447,520). The modified device of Clark/Brown discloses the invention substantially as claimed except for disclosing the second segment has a constant outer diameter. However, Ott discloses (Figs. 3B and 4A, reproduced and annotated below) that the tip of an IOL injector includes first portion 56 and a tip 54, wherein tip 54 includes a third segment, a second segment the second segment has a constant outer diameter. Apparently, the advantage of providing the second segment with a constant outer diameter is to prevent the tip from stretching the incision in the ocular tissue. It would have been obvious to one of ordinary skill in the art to modify the second segment of Clark/Brown tip according to the suggestion of Ott so that it too would have the same advantage.

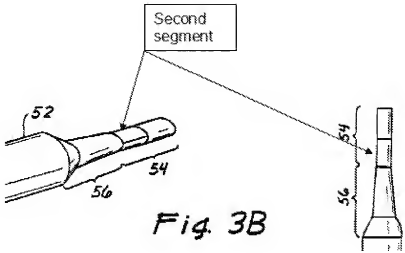


Fig. 3B

Fig. 4A

(10) Response to Argument

As to item **B**, pages 6-7 of the Appeal Brief, applicants argue that the rejection under 35 U.S.C §103(a) over Clark in view of Brown is improper "because none of the art of record discloses "[a] slot extending from [an] open end through [a] second segment and [a] third segment, the third segment connected to the second segment at a transition point, the transition point characterized by a change in taper" and the Examiner's rationale for modifying Clark to include such a configuration is insufficient".

Examiner respectfully traverses applicant remark. Noting that Clark already discloses that the slit (121) is disposed at the distal tip and apparently, the slit extended substantially half way of the length of the elongate distal portion (105) (see annotated figure above). Brown discloses (see annotated figure above) the nozzle (18) of an IOL injector includes a third, a second, and a first segments (see annotated figure above). Apparently, the advantage of having a taper on the outer and inner surfaces on the second segment is for gradually compressing the IOL to fit through a small distal tip, which is the third segment (see annotated figure below), thereby, facilitate insertion of

the injector into a small incision in the ocular tissue. Based on the evidences provided by Clark and Brown references, Examiner contends that it would have been obvious to one of ordinary skill in the art to modify the shape of the elongate distal portion (105) of Clark to have a similar shape according to the nozzle (18) as suggested by Brown so that it too would have the same advantage. Such a tip as modified by Brown would have a slit that does extend from the third segment to the second segment.

As to item **B**, page 8 of the Appeal Brief, applicants argue that "there is no teaching of the modification (i.e., optimization) to Clark as proposed by the Examiner and there is no rationale for making such a modification to Clark. It is worth mentioning that the reason set forth in the Specification of instant application for the slot configuration as recited in claim 1 (i.e., providing a doctor with options for anchoring the tip of the inserter in the eye during injection of a lens" (see page 12, line 13 et seq. of the present application)) is entirely different than any reason set forth in Clark or Brown". Examiner respectfully traverses applicant remark. Noting that Clark already discloses that the slit (121) is disposed at the distal elongate portion (105) (see annotated figure above). In column 6, lines 31-40, Clark discloses "the slits therefore permit lateral expansion of the lens prior to its release into the eye. As a result, the natural resilient force which biases the lens to assume its original uncompressed shape is dissipated in the controlled environment of the cannula. The lens is thus not released with any velocity as in many prior art inserters". The passage above indicates that the the jaw, which is created by two slits (121), is expanded to allow the lens to assume the original configuration. Examiner contends that when the jaw is in the expanded

configuration, it is capable to perform the anchoring function as disclosed in the instant application.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/TUAN V NGUYEN/

Examiner, Art Unit 3731

Conferees:

/(Jackie) Tan-Uyen T. Ho/

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